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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,395	06/20/2001	Delphine Coppens	55550US006	3952
32692	7590	07/25/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			NORDMEYER, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 07/25/2005

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**MAILED**  
JUL 25 2005  
**GROUP 1700**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/885,395  
Filing Date: June 20, 2001  
Appellant(s): COPPENS ET AL.

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Loren D. Albin  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 2, 2005 appealing from the Office Action mailed February 24, 2005.

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Art Unit: 1772

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

U.S. Patent No. 3,758,192 to Bingham, patent on September 11, 1973.

U.S. Patent No. 5,118,750 to Silver et al., patented on June 2, 1992.

U.S. Patent No. 6,194,044 to Stahl, patented February 27, 2001.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 19, 20, 22 and 24 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl (USPN 6,194,044) in view of Silver et al. (USPN 5,118,750).

Claims 21, 23 and 26 – 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl (USPN 6,194,044) in view of Silver et al. (USPN 5,118,750) and Bingham (USPN 3,758,192).

**(10) Response to Argument**

**I. 35 U.S.C. 103(a) rejection over Stahl in view of Silver et al.**

*A. No suggestion or motivation to combine documents*

Appellants argue that there is no suggestion or motivation, either in documents or in the knowledge generally available to one of ordinary skill in the art, to modify the documents as

Art Unit: 1772

discussed in the previous responses. Appellants further argue that the labels as claimed in the present invention can offer useful properties that are not suggested by the cited art.

In response to Appellants' arguments that there is no suggestion or motivation to modify the documents of adhesive of Stahl to have the microspheres of Silver et al., there is clear motivation expressed in Silver et al. to modify the PSA of Stahl to include microspheres, i.e., the microspheres minimize the loss of adhesive capability of the PSA from the repositioning of the adhesive and also minimize transfer of the PSA to the attached substrate (Column 1, lines 16 – 28 and Column 3, lines 12 – 23). Furthermore, there is nothing precluding an adhesive composition from comprising various components exhibiting differential properties, i.e., the mere fact that one element may exhibit a specific property at elevated temperatures does not preclude that element from being combined with a second element that may not exhibit the same property at elevated temperatures.

In response to Appellants' arguments that the labels as claimed in the present invention can offer useful properties that are not suggested by the cited art, it is noted that the features upon which applicant relies (i.e., increased repositionability and increased durability) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The increased repositionability and durability would be latent properties, which would be presented due to the combination of the adhesive layers with the elastomeric microspheres.

*B. Stahl's silence is not a Substitute for Adequate Disclosure Required to Support a Conclusion of Obviousness*

Appellants argue that Stahl's characterization of outer adhesive being pressure and heat sensitive leads away from the claimed invention, and the Examiner has failed to establish a *prima facie* case of obviousness.

In response to Appellants' arguments that Stahl's characterization of outer adhesive being pressure and heat sensitive leads away from the claimed invention, and the Examiner has failed to establish a *prima facie* case of obviousness, the claim clearly states that "a first adhesive layer comprising a heat activatable adhesive; and a second adhesive layer other than a hot melt adhesive layer". As defined by *ODLIS: Online Dictionary for Library and Information Science*, a pressure sensitive adhesive is "An adhesive designed to work by means of gentle compression, which may or may not allow the material to be easily removed from a surface once it has adhered". A hot melt adhesive is defined as "A tough, flexible chemical adhesive used in commercial bookbinding. Solid at room temperatures, hot melt adhesive liquefies under high heat...hot melt adhesive sets up in seconds as it cools, significantly reducing production costs." The fact that Stahl teaches a heat sensitive pressure sensitive adhesive does not make the adhesive a hot melt adhesive. The pressure sensitive adhesive is just effected by the presence of heat, and it still reads on the recited claim limitations as shown by the definitions of pressure sensitive adhesive and hot melt adhesive.

In response to Appellants' arguments that the Examiner has failed to establish a *prima facie* case of obviousness, both the Silver et al. reference and the Stahl reference are directed towards pressure sensitive adhesive material in combination with labels. Silver et al. clearly

Art Unit: 1772

states that it is known to use microspheres to minimize the loss of adhesive capability of pressure sensitive adhesive from the repositioning of the adhesive and also minimize transfer of the pressure sensitive adhesive to the attached substrate (Column 1, lines 16 – 28 and Column 3, lines 12 – 23)

II. 35 U.S.C. 103(a) rejection over Stahl in view of Silver et al. and Bingham

Appellants argue that Bingham fails to provide the motivation to combine documents that is missing from Stahl in view of Silver et al. Appellants argue that the Examiner has failed to establish a *prima facie* case of obviousness.

In response to Appellants' arguments that Bingham fails to provide the motivation to combine documents that is missing from Stahl in view of Silver et al., there is clear motivation expressed in Silver et al. to modify the PSA of Stahl to include microspheres, i.e., the microspheres minimize the loss of adhesive capability of the PSA from the repositioning of the adhesive and also minimize transfer of the PSA to the attached substrate (Column 1, lines 16 – 28 and Column 3, lines 12 – 23). Furthermore, there is nothing precluding an adhesive composition from comprising various components exhibiting differential properties, i.e., the mere fact that one element may exhibit a specific property at elevated temperatures does not preclude that element from being combined with a second element that may not exhibit the same property at elevated temperatures.

In response to Appellants' arguments that the Examiner has failed to establish a *prima facie* case of obviousness, both the Silver et al. reference and the Stahl reference are directed towards pressure sensitive adhesive material in combination with labels. Silver et al. clearly

Art Unit: 1772


states that it is known to use microspheres to minimize the loss of adhesive capability of pressure sensitive adhesive from the repositioning of the adhesive and also minimize transfer of the pressure sensitive adhesive to the attached substrate (Column 1, lines 16 – 28 and Column 3, lines 12 – 23).


For the above reasons, it is believed that the rejections should be sustained.

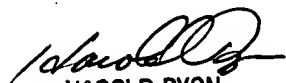
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1772

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